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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mweipdocket@mwe.com

DETAILED ACTION

Claim Objections

1. Claim 37 is objected to because of the following informalities:

In claim 37, line 2, substitute “said” with --a--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 9-12, 16-23, 25-29, 32-34, 36-40, 42-44, 46, and 48-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Patton et al. (US 6,842,533) (hereinafter referred to as ‘Patton’).

Patton teaches

regarding claim 1, a method for producing a transaction card corresponding to an account of a customer and bearing an image defined by said customer, the method comprising:

associating an optically-readable identifier (identification code 118) with a customer defined image (digital image of preapproved image 170) to be applied to the transaction card;

reading said optically-readable identifier to reconcile said optically-readable identifier with a corresponding identifier (authorizing information) associated with customer account information to be applied to the transaction card (col. 6, lines 3-8 and col. 7, lines 21-31); and

producing a transaction card bearing said customer-defined image and said customer account information (col. 4, lines 12-14 and col. 8, lines 17-19);

a method as in claim 1, wherein the step of reconciling said optically-readable identifier with said corresponding identifier associated with said customer account information comprises deriving said corresponding identifier from said customer account information (col. 6, lines 54-57);

a method as in any preceding claim, wherein said customer account information and/or said corresponding identifier related to it are received securely from a card issuing authority (col. 6, lines 3-8);

a method as in claim 1 or 2, wherein said customer account information is provided by a financial transaction card issuer on a secure link to a card finishing facility (col. 4, lines 21-39);

a method as in claim 9, wherein said financial transaction card issuer also provides said corresponding identifier associated to with the customer account information (col. 6, lines 54-57);

a method as in claim 1 or 2, wherein said corresponding identifier associated with the customer account information is derived from the account information (col. 6, lines 54-57);

a method as in claim 1 or 2, wherein said corresponding identifier is derived from financial account information (col. 6, lines 54-57);

a method as in claim 1 or 2, wherein an identifier comprises one or more of:

a numeric code; an alphanumeric code; a text code; a non-sequential code; a one-way code; an encryption code; a bash code; meta tags; another suitable identifier (col. 6, lines 54-57);

a method as in claim 1 or 2, wherein said optically-readable identifier comprises one or more of:

bar code; a digital signature; text; numerals; alpha numeric code; microdot; micro text; invisible ink; digital watermark or other suitable optically readable codes (col. 4, lines 61-64);

a method as in claim 1 or 2, wherein said image and said optically-readable identifier are stored in a storage facility (col. 4, lines 30-35);

a method as in claim 18, wherein said storage facility is on a site controlled by a card graphics hosting service (col. 4, lines 21-25);

a method as in claim 18, wherein said storage facility is on a site of a card finishing facility (col. 4, lines 21-25);

a method as in claim 18, wherein said storage facility is on a site of a card manufacturer (col. 4, lines 21-25);

a method as in claim 1 or 2, wherein cards with optically-readable identifiers are transferred from the card manufacturer's control to a card finishing facility (col. 5, line 60-col. 6, line 16);

a method as in claim 1 or 2 wherein, one or more of the customer-defined image and the optically-readable identifier is placed on the front of a card (col. 8, lines 6-9);

a method as in claim 1 or 2, wherein the customer has generated said customer-defined image;

a method as in claim 1 or 2, wherein the customer has manipulated said customer-defined image (col. 3, line 60-col. 4, line 9);

a method as in claim 1 or 2, wherein the customer has selected said customer-defined image (col. 3, line 60-col. 4, line 9);

a method as in claim 27, wherein an image is selected by a customer from an available collection of images (col. 3, line 60-col. 4, line 9);

a method as in claim 1 or 2, wherein said customer-defined image is uploaded by a customer by means of the internet (col. 3, line 60-col. 4, line 9);

a method according to claim 1 or 2, wherein identifiers for card authorized to be issued are received by a card graphics hosting service from an authorized card issuer such that only customer-defined images destined for cards authorized to be issued are supplied for downstream processing (col. 7, lines 31-64);

a method according to claim 1 or 2, wherein said customer-defined image can be manipulated in relation to a template displaying one or more non-manipulateable card features (col. 3, line 60-col. 4, line 9);

a method as in claim 1 or 2, wherein only account information is transferred from a card issuing authority to a card finishing facility (col. 4, lines 21-27);

a method according to claim 1 or 2 wherein said optically-readable identifier is applied to a card in more than one format (col. 4, line 58-64);

a method according to claim 1 or 2, wherein a finishing facility (thermal printer 130) causes customer-defined images to be provided from an image store based on reconciliation of identifiers;

a method according to claim 1 or 2, wherein said optically-readable identifier is embedded in said customer-defined image (col. 4, lines 58-64);

a method as in claim 1 or 2, wherein said optically-readable identifier from which it is derived is generated by said card graphics hosting service (col. 4, lines 27-30);

regarding claim 38, a method of producing a transaction card corresponding to an account of a customer and bearing an image defined by said customer, comprising a step of associating an optically-readable identifier with a customer-defined image;

regarding claim 39, a method for production of a transaction card bearing account information and a customer-defined image, the method comprising:

receiving an identifier generated from account information of a customer;

generating an optically-readable identifier corresponding to said received identifier;

associating said optically-readable identifier with an image defined by said customer;

receiving a corresponding identifier; and

reconciling said corresponding identifier and said optical identifier associated with the customer-defined image to cause production of a card bearing the customer-defined image and relevant customer account information;

a method as in claim 39, wherein said step of associating said optically-readable identifier with an image is performed by a card graphics hosting service;

regarding claim 41, a method for producing a transaction card bearing account information and a customer-defined image, the method comprising:

receiving from a card issuing authority an identifier derived from customer account information;

embedding an optically readable version of said identifier in an image defined by said customer (col. 4, lines 58-64);

receiving said account information at a card production facility and independently generating a corresponding identifier therefrom;

applying relevant account information and said customer defined image to a transaction card based on reconciliation of said corresponding identifier and said encoded version of the identifier;

regarding claim 43, a method for producing a personalized product bearing an image defined by said customer comprising:

providing a graphics hosting facility to permit customers to define an image to be applied to products (col. 3, line 60-col. 4, line 9);

associating an optically-readable identifier with the image; and
reconciling said optically-readable identifier with a corresponding identifier such that said image is applied to a product intended for said customer;

regarding claim 46, apparatus capable of performing steps in the production of transaction cards bearing customer-defined images; comprising:

means for providing an interface for generating a customer defined image by means of the internet; and

means for embedding an optically readable identifier in a customer defined image;

regarding claim 47, an apparatus for producing transaction cards bearing customer-defined images, comprising:

means for receiving a customer defined image comprising an embedded optically readable identifier; and

means for reading said embedded optically-readable identifier;

regarding claim 48, an apparatus for producing transaction cards bearing customer-defined images comprising:

means for receiving a card bearing a customer-defined image comprising an optically-readable identifier;

means for receiving at least financial information (credit card number) relating to a corresponding identifier (col. 4, lines 12-14);

means for reconciling said optically-readable identifier and said corresponding identifier;

means for applying account information to a transaction card bearing said customer-defined image response to said reconciliation step;

apparatus as in claim 48, further comprising means for deriving said corresponding identifier from said account information;

apparatus as in claim 48, wherein said customer-defined image comprises an embedded optically readable identifier;

apparatus as in claim 48, wherein said step of reconciling comprises reading said optical identifier and encoding a magnetically readable version of the identifier in a magnetic strip;

regarding claim 52, A method for producing a transaction card corresponding to an account of a customer and bearing an image defined by the customer, the method comprising:

providing an interface for a customer to generate a customer-defined image to be applied to a transaction card;

associating an optically-readable identifier with said customer-defined image; and
reconciling the encoded version of the identifier with a corresponding identifier related to
customer account information to generate a transaction card bearing said customer-defined
image and said customer account information.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the
manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the
claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various
claims was commonly owned at the time any inventions covered therein were made absent any
evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out
the inventor and invention dates of each claim that was not commonly owned at the time a later
invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)
and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 5, 7, 8, 41, 47, and 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton in view of Barnes et al. (US 3,761,682) (hereinafter referred to as 'Barnes').

The teachings of Patton have been discussed above.

Patton lacks the teaching of an identifier encoded onto a recording medium on a transaction card.

Barnes teaches an identifier encoded onto a recording medium on a transaction card (col. 3, line 66-col. 4, line 5).

One of ordinary skill in the art would have readily recognized that providing the Patton invention with the identifier encoded onto a recording medium would have been beneficial for ensuring that the necessary information is retained. Therefore it would have been obvious at the time the invention was made to modify the teachings of Patton with the aforementioned teaching of Barnes.

8. Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton in view of Solo (US 4,562,342).

The teachings of Patton have been discussed above.

Patton lacks the teaching of an embossed record.

Solo teaches account information comprising an embossed record for a financial transaction card (see figure 1).

One of ordinary skill in the art would have readily recognized that customer account information in the form of embossed information is readily recognizable to the human eye and a machine, thereby allowing the information contained therein to be discernable in any fashion for further reference. Therefore it would have been obvious at the time the invention was made to modify the teachings of Patton with the aforementioned teaching of Solo.

9. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton in view of Lessin et al. (US 4,868,379) (hereinafter referred to as 'Lessin').

The teachings of Patton have been discussed above.

Patton lacks the teaching of an encryption module.

Lessin teaches encryption of a secured identifier from account information (col. 14, lines 1-4).

One of ordinary skill in the art would have readily recognized that providing the Patton invention with an encryption module would have been obvious for ensuring that data which is encrypted would be in a protected format until the data is decrypted by an authorized party, thereby keeping important information safe against wrongful parties. Therefore it would have been obvious at the time the invention was made to modify the teachings of Patton with the aforementioned teaching of Lessin.

10. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patton.

The teachings of Patton have been discussed above.

Patton lacks the teaching of one or more of the customer-defined image and said optically-readable identifier is placed on the back of a card.

Although Patton lacks the teaching of one or more of the customer-defined image and said optically-readable identifier is placed on the back of a card, one of ordinary skill in the art would have readily recognized that providing an image on the front or back of a card would have been obvious since the image may be viewed for review regardless of the location of the image on the card, thereby rendering the image a useful security element in any position. Therefore it would have been obvious at the time the invention was made to modify the teachings of Patton.

8. Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton in view of Bloomberg et al. (US 6,827,277) (hereinafter referred to as 'Bloomberg').

The teachings of Patton have been discussed above.

Patton lacks the teaching of the optically readable identifier in a location that is subsequently covered by another feature.

Bloomberg teaches an optically readable identifier on a transaction card in a location that is subsequently covered by another feature (see figure 3);

wherein the feature is selected from one or more of:

a chip; a hologram; or a brand (see figure 3).

One of ordinary skill in the art would have readily recognized that providing the Patton invention with the optically readable identifier in a location that is subsequently covered by another feature would have been beneficial for not only for security layering purposes, but also for the purpose of allowing the card to accommodate more security features in the given physical

space of the card. Therefore it would have been obvious at the time the invention was made to modify the teachings of Patton with the aforementioned teaching of Bloomberg.

9. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patton.

The teachings of Patton have been discussed above.

Patton lacks the teaching of the optically-readable identifier removed to generate a finished card.

One of ordinary skill in the art would have recognized that providing the allowing the optically-readable identifier to be removable would have been beneficial since the removal of the optically-readable identifier could allow a user to retain the optically-readable identifier for future use, separate from the card. Furthermore, to make a feature separable has been found to be an obvious step in re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) (The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is "press fitted" and therefore not manually removable. The court held that "if it were considered desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose."). Therefore it would have been obvious at the time the invention was made to modify the teachings of Patton.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMARA FRANKLIN whose telephone number is (571)272-2389. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamara A. Franklin/
Primary Examiner, Art Unit 2876

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JAF